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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/591,326	08/31/2006	Naoki Nishiura	VX062753 PCT	9434

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POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON, VA 20191

EXAMINER

FANG, SHANE

ART UNIT	PAPER NUMBER
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1766

NOTIFICATION DATE	DELIVERY MODE
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05/09/2011

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/591,326

Applicant(s)

NISHIURA ET AL.

Examiner

SHANE FANG

Art Unit

1766

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 31 March 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
The declaration has been entered. See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/RANDY GULAKOWSKI/
Supervisory Patent Examiner, Art Unit 1766

/SHANE FANG/
Examiner, Art Unit 1766

Continuation of 11. does NOT place the application in condition for allowance because: The submitted 1.132 Declaration shows no evidence of comparing with closest prior arts cited to rebut the previous 103 rejection. The whole document merely contains arguments that are repeated in submitted Applicant Arguments/Remarks. Thus, this 1.132 is found insufficient. See below response.

The applicant argued (Pg. 6-7) Kanetake and Economy cannot be combined because they are in different technical fields: Kanetake teaches carbon filled polyimide film, while Economy teaches a polyimide film comprising amino-terminated amic acid oligomer and a tetracarboxylic diester of an alcohol as essential component; combining Kanetake and Economy would provide a polyimide film with electron withdrawing group; no TSM has been shown to combine Kanetake and Economy. The examiner disagrees.

First, all cited references are directed to the field of applicant's endeavor. Kanetake (primary reference) pertains to polyamic acid composition for carbon filled polyimide films (claims). Hasegawa pertains to polyamic acid composition for making polyimide films (Pg. 388, left col.). Wilson (as evidence) teaches general principle of polyamic acid conversion to polyimide films. The examiner thanks applicant's acknowledgement of Economy teaching producing a polyimide film on a substrate (Pg.6, last line of 3).

Second, flatness is an issue the present invention attempts to solve (Instant 0008), and Economy solves the same problem by improving the planarization. Economy is reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention.

Thirdly, the applicant attacked Kanetake and Economy. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See MPEP-2145.

Finally, a polyimide film without electron withdrawing group is not what claimed. Kanetake is silent on polyamic acid being oligomeric and prepared from multiple asymmetric and symmetric dianhydrides. Economy discloses a composition comprising oligomeric polyamic acid (PMDA-ODA) and ester having a MW range meeting that of claim 12. Economy further discloses the composition would yield a polyimide film and coating with good planarization, mechanical and thermal stability, and excellent flexibility. Hasegawa discloses a polyimide prepared by blend of a first polyamic acid (symmetric dianhydride (s-BPDA) with diamine) (80%) and a second polyamic acid (asymmetric dianhydride (a-BPDA) with diamine) (20%) to improve the thermal processability of polyimide based on BPDA/diamine without decreasing the Tg (Abs.). Hasegawa discloses said polyimide has improved mechanical properties compared to polyimide based on PMDA/ODA can be used in films and composite (1, P.387). As evidenced by Wilson et al., the blending would results in a polyamic acid composition having same structure and reaction sequence as recited in claims 9 and 11.

In light of this, the examiner asserts Economy and Hasegawa teach motivations to be combined with Kanetake. The combination of above four references would result in the claimed composition.

Therefore, as to claims 7-8, 10, and 12-16, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the composition and process disclosed by Kanetake, replaced the polyamic acid with the oligomeric polyamic acid (PMDA-ODA) composition in view of Economy, and further replaced the PMDA-ODA polyamic acid of Economy with the asymmetric/symmetric dianhydride ratio in view of Hasegawa, because the resultant composite film would have improved good planarization, thermal stability, and excellent flexibility, thermal processability and retained Tg, and further improved mechanical properties.

Particular to claim 8, all four references discloses or implies the reaction at room temperature. All four references are silent on the reaction temperature of claim 10. Claims 8 and 10 are product-by-process claims that are limited by and defined by the product. Determination of patentability is based on the product itself, not on its method of production. See MPEP § 2113. Instant 0170-0174 indicates these reaction temperature ranges are used to produce oligomers having Mn of 1k to 7k. In this particular case, the resultant oligomeric polyamic acid meets the chemical and molecular weight requirement of claims 8 and 10.

The applicant further argued the claimed polyimide film having unexpected results (Pg. 8) without showing evidence comparing with the closest arts cited. This argument is not persuasive for not showing evidence. It is notified no evidence of comparing with closest prior arts is shown in the submitted 1.132.

Therefore, the previous 103 rejections of claims 7-8, 10, and 12-16 over Kanetake et al. in view of Economy et al. in further view of Hasegawa et al. and evidenced by Wilson et al. have been maintained.

The applicant has traversed the ODP rejection by arguing 12/441980 is a later filed application (Pg.8-9) and this application is filed much earlier, and therefore the rejection should be withdrawn. Applicants are reminded that, if two (or more) pending applications are filed, in each of which a rejection of one claimed invention over the other on the ground of provisional **nonstatutory< double patenting (ODP) is proper, the >provisional< ODP rejection will be made in each application. If the >provisional< ODP rejection is the only rejection remaining in the earlier-filed of the two pending applications, (but the later-filed application is rejectable on other grounds), the examiner should then withdraw *>the provisional ODP< rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. If the >provisional< ODP rejection is the only rejection remaining in the later-filed application, (while the earlier-filed application is rejectable on other grounds), a terminal disclaimer must be required in the later-filed application, before the >provisional< ODP rejection can be withdrawn. If the >provisional< ODP rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw the >provisional< ODP rejection in the earlier-filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the >provisional< ODP rejection can be withdrawn and the application be permitted to issue. See MPEP- 1490 (V). D, 804B.2. In this case, we have other rejections remaining; rejections have to be maintained and addressed (not held in abeyance, as requested) as required by the MPEP; it is possible that a double patenting rejection in the later case may not be appropriate, therefore why would applicants' file a TD in that case if one cannot be made; and finally, it is not the office's issue/problem that this case was filed "much earlier" than the case cited above. For these reasons the ODP is deemed proper and maintained.

Therefore, the previous ODP rejections over 12/441980 have been maintained..